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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,936	03/26/2004	Richard Duk Wong Hahn	Hahn.R-15	9886

22197 7590 06/08/2006

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EXAMINER

KATCHEVES, BASIL S

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/810,936

Applicant(s)

HAHN, RICHARD DUK WONG

Examiner

Abdul Manaf

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05/04/2005</u> , <u>3/14/05</u>   | 6) <input checked="" type="checkbox"/> Other: <u>MARKED FIGURE</u>          |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1 – 6 are rejected on the ground of nonstatutory double patenting over claims 1 and 2 of U. S. Patent No. 6,755,000 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a molding tile apparatus for mounting onto abutting wall surfaces having a first and a second wall abutment vicinity (forming a seem, an inside and an outside corner) comprising a first and a second corner turning portion, a

separate leg portion integral with each of the first and second corners; and having a recess and an insert.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

In regard to claim 1, the U.S. Patent No. 6,755,000 claims a molding tile apparatus comprising a first horizontal, lateral extent corner turning portion having a leg portion integral with the first corner turning portion, both having an interface between them defined by a thickness differential (claim 1).

In regard to claim 2, the U.S. Patent No. '000 claims a molding tile apparatus wherein the corner-turning portion provides a frontal recess, and further comprising a separable frontal decorative insert adapted (claim 1).

In regard to claim 3, the U.S. Patent No. '000 claims a molding tile apparatus comprising a second corner turning portion integral with the leg portion and spaced apart from the first corner turning portion in opposing juxtaposition, the second corner turning portion having a horizontal, lateral extent; an interface between the leg portion and the second turning portion defined by a thickness differential (claim 1).

In regard to claim 4 the U.S. Patent No. '000 claims a molding tile apparatus wherein the second corner-turning portion provides a frontal recess, and further comprising a separable frontal decorative insert (claim 2).

In regard to claim 5, the U.S. Patent No. '000 claims a molding tile apparatus comprising a wall abutment vicinity forming an inside and an outside corner, wherein combination the apparatus comprising a corner turning portion having a horizontal, lateral extent; and at least one separate, horizontally oriented, linearly extensive, leg portion abutting the corner turning portion; the interface between each of the leg portions and the corner turning portion is defined by a thickness differential (claims 2).

In regard to claim 6, the U.S. Patent No. '000 claims a molding tile apparatus wherein the corner turning portion comprising a separable frontal decorative insert (claim 1).

### ***Claim Objections***

Claim 5 is objected to because of the following informalities: "portions" in line appears to be a typographical error. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 – 6 are rejected under 35 U.S.C. 102(b) as being anticipated by the U.S. Patent 6,309,036 to Ancel.**

In regard to claim 1, Ancel discloses a molding tile apparatus 10 comprising a first horizontal, lateral extent corner turning portion 24 having a leg portion 12 integral

with the first corner turning portion, both having an interface between them defined by a thickness differential (see Marked Fig.).

In regard to claim 2, Ancel discloses a molding tile apparatus wherein the corner-turning portion provides a frontal recess 26, and further comprising a separable frontal decorative insert (see Marked Fig.) adapted.

In regard to claim 3, Ancel discloses a molding tile apparatus comprising a second corner turning portion 75 integral (Abstract) with the leg portion and spaced apart from the first corner turning portion in opposing juxtaposition (Fig. 3), the second corner turning portion having a horizontal, lateral extent; an interface between the leg portion and the second turning portion defined by a thickness differential (see Marked Fig.).

In regard to claim 4, Ancel discloses a molding tile apparatus wherein the second corner-turning portion provides a frontal recess (see Marked Fig.), and further comprising a separable frontal decorative insert (see Marked Fig.).

In regard to claim 5, Ancel discloses a molding tile apparatus 10 comprising a wall abutment vicinity forming an inside and an outside corner (see Marked Fig.), wherein combination of the apparatus is comprising a corner turning portion 75 having a horizontal, lateral extent; and at least one separate, horizontally oriented, linearly extensive, leg portion 12 abutting the corner turning portion; the interface 75 between each of the leg portions and the corner turning portion is defined by a thickness differential (see Marked Fig.).

In regard to claim 6, Ancel discloses a molding tile apparatus wherein the corner turning portion comprising a separable frontal decorative insert (see Marked Fig.).

**Contact Information**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdul Manaf whose telephone number is 571-272-1476. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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05/18/2006

  
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